

REMARKS/ARGUMENTS

Claim Rejections - 35 USC § 112

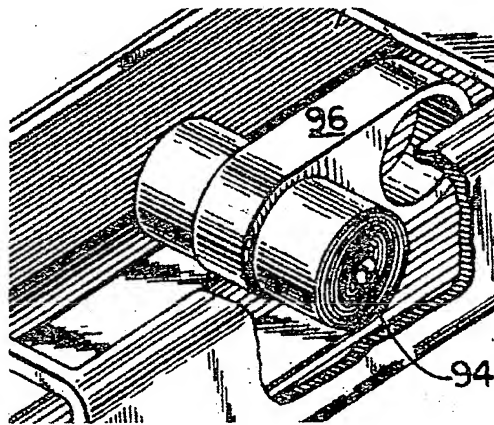
1. The Examiner rejected claims 7-12 under §112, second paragraph as being indefinite.
2. Applicant has amended claim 7 to provide definiteness for claims 7-12. Such changes add no new matter.

Claim Rejections - 35 USC § 102

3. The Examiner rejected claims 1-3 under §102(b) as being anticipated by Burke, et al. ("Burke"), U.S. Patent No. 5,337,860.
4. The Examiner rejected claims 1-3 under §102(b) as being anticipated by Brinkerhoff, U.S. Patent No. 282,837.
5. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
6. Burke shows a solid lubricant stick having a pair of channels defined in both (what the Applicant refers to as) the top face and the bottom face of the stick. The channels appear to extend from the first end to the second end of the stick.
7. Claim 1, as previously presented, claims:
 1. (Previously Presented) A right rectangular parallelepiped lubricant stick, said stick having a first end extending to second end, said first end for contacting a surface to be lubricated, said **second end for contacting a constant force spring of a lubricant applicator**, said constant force spring for holding said first end

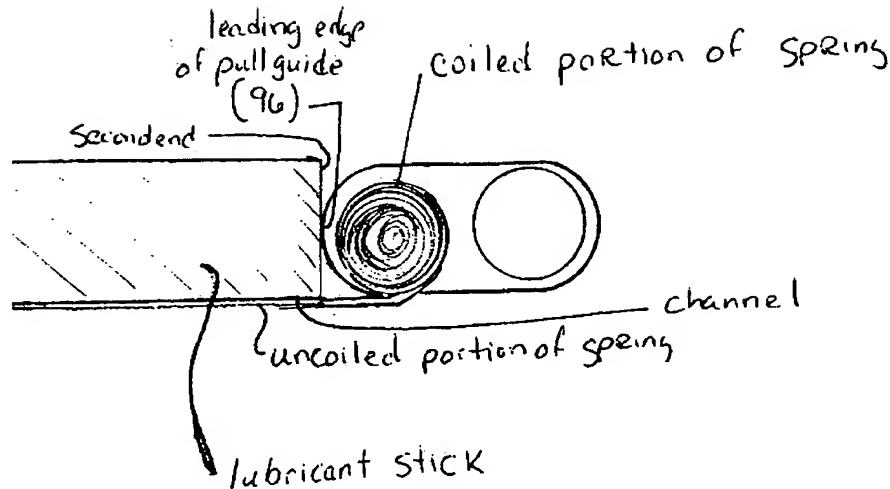
against said surface to be lubricated, said constant force spring comprising a first portion extending to a coiled second portion, said first portion configured to attachment to said lubricant applicator, wherein **said second end defines therein a channel for receiving at least a portion of said coiled second portion.** (emphasis added)

8. Element—"second end for contacting a constant force spring of a lubricant applicator." Burke's drawings (Fig. 7) show a pull guide (96) which the coiled springs attach to.



9. The drawing (Fig. 7) clearly showing that the pull guide (96) extends past the springs. Thus, a lubricant stick held within the applicator would contact the leading edge of the pull guide (96) and not the coiled springs. Thus, the second end of Burke's lubricant stick does not contact a constant force spring of a lubricant applicator. Burke does not anticipate.

10. Applicant's attorney had crudely sketched what he believes is how the Burke stick would look when in the Burke applicator:



This sketch, albeit crude, reinforcing Applicant's point above that the second end of Burke's lubricant stick does not contact a constant force spring of a lubricant applicator. Burke does not anticipate. Applicant notes that this is what Burke shows in its figures. However, as Burke winds up (not shown in its figures), the spring may or may not actually touch the lubricant stick. That is unknown.

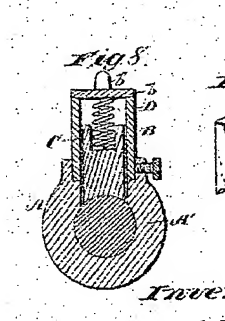
11. Element--"said second end defines therein a channel for receiving at least a portion of said coiled second portion." Referring back to the crude sketch above, the second end of Burke does not define a channel therein for receiving at least a portion of said coiled second end because (1) the second end doesn't touch the coiled spring and (2) even if it did, the coiled portion wouldn't reside in the channel. Thus, Burke does not anticipate.

12. Claims 2-3 depend from claim 1. In that claim 1 is not anticipated, claims 2-3 are likewise not anticipated by Burke.

13. As for the Brinkerhoff lubricating mechanism, Brinkerhoff discloses a "conductor" made of a material of "sufficient porosity, either throughout or in a portion of its body, to permit the passage of the lubricant by capillary action or by permeation, whereby the conductor itself may become a saturated block to furnish the necessary required lubrication." (Brinkerhoff,

col. 2, ll. 64-72). Whereas, the present invention is a "lubricant stick" as is typically used today. Such a modern "lubricant stick" not a porous block of material but instead a consumable piece which is frictionally applied to the surface lubricated, the lubricant stick being consumed in the process. Brinkerhoff, as such, does not show a "lubricant stick" and therefore cannot anticipate.

14. The Brinkerhoff lubricating mechanism shows the use of a compression spring:



The present invention, rather, utilizes a constant force spring, as mentioned in paragraph [0035].

15. Applicant has (previously) amended claim 1 to further define the stick of the present invention is utilized with a constant force spring. To this, the Examiner argues that "the constant force spring is not given a patentable weight since the claims only claim the lubricant stick and the recitation of the constant force spring is only an intended use language."

16. However, the intended use language should be considered and given weight because the intended use language is not in the preamble. Where the claim terms recite a property or intended use distinguishable from the prior art, an anticipation rejection may not be appropriate. See *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (C.C.P.A. 1974) (explaining that "such terms must define, indirectly at least, some characteristic not found in the old composition"). In this case, *Pearson* does not, nor cannot, use a constant force spring. Because of that, claim 1 recites a property or intended use which is distinguishable from the prior art thereby resulting in the anticipation rejection being inappropriate.

17. That being said, claim 1 requires that the constant force spring comprise "a first portion extending to a coiled second portion, said first portion configured for attachment to said lubricant applicator, wherein said second end defines therein a channel for receiving at least a portion of said coiled second portion."
18. The Brinkerhoff spring does not have a first portion extending to a coiled second portion (a compression spring) but instead is a compression spring (continuous coil from first end to second end).
19. As such, each and every element as set forth in independent claim 1 is not found, either expressly or inherently described in Brinkerhoff. Claims 2-3 depend from claim 1. In that claim 1 is not anticipated, claims 2-9 are likewise not anticipated.
20. Further, to constitute an anticipatory reference, the prior art must contain an enabling disclosure. *Chester v. Miller*, 906 F.2d at 1576 n.2, 15 USPQ.2d at 1336 n.2 (Fed. Cir. 1990); see also *Titanium Metals Corp. of America v. Banner*, 778 F.2d at 781, 227 U.S.P.Q. at 778 (Fed. Cir. 1985).
21. A reference contains an enabling disclosure if a person of ordinary skill could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself, and thereby the public, in possession of the invention. *In re Donohue*, 766 F.2d 531, 533, 226 USPQ. 619, 621 (Fed. Cir. 1985); *In re Sheppard*, 339 F.2d 238, 242, 144 USPQ. 42, 45 (C.C.P.A. 1964).
22. Brinkerhoff does not contain an enabling disclosure of the invention of claim 1 because as the lubricant stick of the type referred to in the present invention wears off (lubricant is applied to the surface to be lubricated), a spring must be provided which pushes unworn lubricant stick into contact with the surface constantly so as to continue to apply lubrication to the surface. In Brinkerhoff's case, the "lubricant stick" is merely a porous applicator that doesn't substantially wear but applies a liquid lubricant to the surface through its contact. Thus, utilization of the compression spring in the present invention (in lieu of the constant force spring disclosed) would not be enabling, for the device would not work.
23. Brinkerhoff does not anticipate.

Claim Rejections - 35 USC § 103

24. The Examiner rejected claims 1-12 under §103(a) as being unpatentable over Szatkowski, et al., USPN 5,251,724 ("Szatkowski") in view of Bitdinger, et al., USPN 5,478,316 ("Bitdinger").

25. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

26. Claim 1, as previously amended, claims:

1. (Previously Presented) A right rectangular parallelepiped lubricant stick, said stick having a first end extending to second end, said first end for contacting a surface to be lubricated, said second end for contacting a constant force spring of a lubricant applicator, said constant force spring for holding said first end against said surface to be lubricated, said constant force spring comprising a first portion extending to a coiled second portion, said first portion configured to attachment to said lubricant applicator, wherein **said second end defines therein a channel for receiving at least a portion of said coiled second portion.** (emphasis added)

27. Claim 7 as currently amended claims:

7. (Currently Amended) A lubricant stick and coiled constant force spring combination for lubricating a surface, said combination configured for utilization with a lubricant applicator, said spring having a coiled portion, said combination comprising:

a lubricant stick having a stick first end ~~opposing~~extending to a stick second end, said stick first end ~~[[,]]~~ configured for contacting said surface, ~~said stick first end extending to a stick second end, said stick [[,]] second end for cooperating with a constant force spring, said stick second end defining a channel for receiving the coiled second end of said spring therein, said wherein when said coiled constant force spring is uncoiled, said remaining coil is held within said channel, thereby applying a constant force holding said stick upon said surface to be lubricated;~~ a coiled constant force spring, said spring having a spring first end extending to a spring second end, said first end comprising an attachment for attaching to said lubricator, ~~the portion of said spring~~ coiled between~~extending from~~ said spring first end to said spring second end ~~coiled, said coiled spring second end configured for receipt into said channel;~~ and wherein as said lubricant stick is dispensed via said lubricant applicator said lubricant stick shortens and said spring coils thereby applying a constant force holding said lubricant stick first end against said surface.

28. Thus, both independent claims (1 and 7) require that the second end of the lubricant stick define therein a channel for receiving at least a portion of the spring's coiled second portion.

29. Szatkowski shows a lubricant stick, but (as the Examiner admits) "fails to show a channel formed at the second end of the lubricant stick."

30. The Examiner argues out that Bitdinger supplies the missing element. Applicant disagrees. Bitdinger shows an "automatic self-injection device," aka syringe. This syringe having a coiled spring and rod (46) having built therein an integral saddle (48) which cooperates with the coiled spring.

31. The law regarding obviousness is clear—any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to

produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fitch, 972 F.2d 1260, 23 USPQ2d 1780, 1783-4 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

32. The Examiner must prove motivation to modify the prior art. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"), see also *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) ("the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"). The Examiner has not shown any motivation to modify the prior art within the reference themselves.

33. There is no motivation whatsoever provided by Szatkowski to provide a lubricant stick with a channel in its second end. It is submitted that the combination of Szatkowski's lubricant stick with Bitdinger's syringe assembly to arrive at a lubricant stick with a channel in its second end for receiving a coiled spring is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in Applicant's claims. The references just do not disclose, teach or suggest it.

34. Further, Szatkowski and Bitdinger are complete and functional without the need for modification. Absent the need for modification to provide functionality, the references could never lead one to make modifications to meet the claims.

35. The Examiner has not met his burden of showing a prima facie case and as such the obviousness rejection is improper.

36. ***Non-Analogous Prior Art.*** Further, only references from arts analogous to that of the claimed invention may comprise prior art to the invention. A reference will only be analogous art if: 1) it is from the same field of endeavor as the claimed invention; or 2) it is from a different field of endeavor, but the reference is reasonably pertinent to the particular problem solved by the inventor. *In re Oetiker*, 977 F.2d 1443, 1446-47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 658-89 (Fed. Cir. 1992). In the *In re Clay* case, the subject claims were directed to a process which improved removal of oil products from storage tanks. The Examiner in that case cited a patent directed to improving production of oil from underground formations. The Federal Circuit held that the cited patent was not analogous art even though the cited patent and subject application both related to the oil industry.

37. The Bitdinger reference (a medical syringe) is not within the field of Applicant's endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because a person of ordinary skill, seeking to solve a problem of railway lubricant sticks would not reasonably be expected or motivated to look to medical devices, namely syringes.

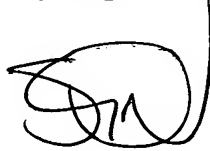
38. Bitdinger is non-analogous prior art.

CONCLUSION

For these reasons, the claims are not anticipated, nor are the obvious. If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 17th day of January 2006.

Very respectfully,



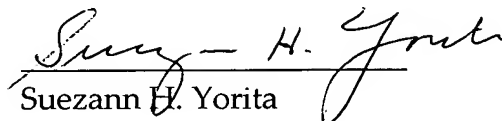
STEPHEN M. NIPPER
Reg. No. 46,260
(208) 345-1122

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

DATE: January 17, 2006



Suezann H. Yorita